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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,889	10/25/2001	Michael W. Munro	10010672-1	7584

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EXAMINER

HANNE, SARA M

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/003,889	Applicant(s) MUNRO, MICHAEL W.	
	Examiner Sara M Hanne	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-8,14 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-8,14 and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment received on July 2, 2004. Amended Claims 1, 4-7, 14 and 16-17 and originally presented claims 8 and 18-19 are pending in the application.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "searching the attachment" and "auto-searching" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5-8 recite the limitation "said outgoing message" in line 2 of Claim 5 should read "said outgoing electronic message" for consistency because there is insufficient antecedent basis for these limitations in the claims as worded.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu, US Patent 5933477 and further in view of Pollack, US Patent 6505236.

As in Claim 1, Wu et al. teaches a method for searching the content of an outgoing electronic message for date information from which an expiration date is related ("checks whether the message has an associated expiration date and time at step 510", Column 4, lines 46-47) and the expiration date to be sent with the content to a recipient ("messaging system 104 sends the message and its associated information", Column 4, lines 29-30 and Figure 3, step 310). While Wu teaches the method for searching for date information and including an expiration date to be sent with a message they fail to show the attachment feature, as in Claim 1. In the same field of the invention, Pollack teaches an electronic messaging system similar to that of Wu. In addition, Pollack further teaches scanning of the attachment to the message and scheduling it's deletion (Fig. 1-2 and corresponding text). It would have been obvious to one of ordinary skill in the art, having the teachings of Wu and Pollack before him at the time the invention was made, to modify the searching for date information in an electronic message and sending outgoing message with an expiration date taught by Wu to include the attachment and expiration date appended to the message of Pollack, in order to obtain a searching method for date information in an attachment and an way to include the expiration date by setting apart from the message content. One would have been motivated to make such a combination because a more in depth searching method and a way to signal the receiving user of the inclusion of an expiration date would have been obtained, as taught by Pollack.

As in Claim 4, Wu teaches searching the content of an outgoing message for date information and sending an outgoing message including an expiration date based on date information (see Claim 1 rejection *supra*). While Wu teaches the method for searching for date information and including an expiration date to be sent with a message they fail to show the expiration date to be appended to the electronic message as in Claim 4. In the same field of the invention, Pollack teaches an electronic messaging system similar to that of Wu. In addition, Pollack further teaches scanning of the attachment to the message and scheduling its deletion (Fig. 1-2 and corresponding text). It would have been obvious to one of ordinary skill in the art, having the teachings of Wu and Pollack before him at the time the invention was made, to modify the searching for date information in an electronic message and sending outgoing message with an expiration date taught by Wu to include the attachment and expiration date appended to the message of Pollack, in order to obtain a searching method for date information in an attachment and a way to include the expiration date by setting apart from the message content. One would have been motivated to make such a combination because a more in depth searching method and a way to signal the receiving user of the inclusion of an expiration date would have been obtained, as taught by Pollack.

As in Claim 5, Wu et al. teaches the expiration date to be inserted in the outgoing electronic message (Column 4, lines 28-33).

As in Claim 6, Wu et al. teaches the recipient receiving the outgoing message and attachment and deleting it after the expiration date (Figure 5, Steps 521 and 523-524 and corresponding text).

5. Claims 7-8, 14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu, US Patent 5933477 and Pollack, US Patent 6505236, and further in view of MacPhail et al., US Patent 5107419.

As for Claims 7, 14 and 17, Wu and Leonard teach searching the content of an outgoing message and attachment for date information and sending an outgoing message and attachment including an expiration date based on date information (see Claim 1 rejection *supra*). Wu further teaches a system running on a processing unit allowing the user to construct electronic messages based on inputs from an input device (Column 4, lines 11–20 and Figure 1), as recited in Claim 14, an auto-searching module to search the electronic message for date information (“messaging system 104 checks whether the message has an associated expiration date and time at step 510”, Column 4, lines 46-47) and an electronic messaging program, running on a processing unit (processor 120) receiving electronic messages from a sender (Column 3, lines 57-64), as recited in Claim 17. Wu also teaches prompting the sender of the outgoing message for an expiration date (Column 4, lines 16–18). While Wu and Pollack teach a system for constructing and a system for receiving electronic messages, auto-searching for date information and prompting the sender of the outgoing message for an expiration date, they fail to show the suggesting expiration dates based on date information as

recited in claims 7, 14, and 17. In the same field of the invention, MacPhail et al. teaches a messaging similar to that of Wu and Pollack. In addition, MacPhail et al. further teaches suggesting an expiration date to the user ("The allowable values have been preestablished then appear in a "window" or on a separate screen", Column 7, lines 21-23 and Column 11, lines 18-19). It would have been obvious to one of ordinary skill in the art, having the teachings of Wu and Pollack and MacPhail et al. before him at the time the invention was made, to modify the messaging and receiving system and method with auto-searching for date information and prompting methods taught by Wu and Pollack to include the expiration date suggestions of MacPhail et al., in order to obtain a user interface for assigning expiration dates suggested by the system. One would have been motivated to make such a combination because a user-supervised method and system for removing emails after a set date would have been obtained, as taught by MacPhail et al.

As for Claim 8, Wu and Leonard teach searching the content of an outgoing message and attachment for date information and sending an outgoing message and attachment including an expiration date based on date information (see Claim 1 rejection *supra*). Wu further teaches a system running on a processing unit allowing the user to construct electronic messages based on inputs from an input device (Column 4, lines 11-20 and Figure 1), as recited in Claim 14, an auto-searching module to search the electronic message for date information ("messaging system 104 checks whether the message has an associated expiration date and time at step 510", Column 4, lines 46-47) and an electronic messaging program, running on a processing unit (processor

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120) receiving electronic messages from a sender (Column 3, lines 57-64), as recited in Claim 17. Wu also teaches prompting the sender of the outgoing message for an expiration date (Column 4, lines 16-18). While Wu and Pollack teach a system for constructing and a system for receiving electronic messages, auto-searching for date information and prompting the sender of the outgoing message for an expiration date, they fail to show the suggesting expiration dates based on date information as recited in claims 7, 14, and 17 and confirmation that the user accepts the expiration date as in Claim 8. In the same field of the invention, MacPhail et al. teaches a messaging similar to that of Wu and Pollack. In addition, MacPhail et al. further teaches suggesting an expiration date to the user ("The allowable values have been preestablished then appear in a "window" or on a separate screen", Column 7, lines 21-23 and Column 11, lines 18-19) and receiving a confirmation that a sender of an outgoing message accepts the expiration date (Column 7, lines 23-25). It would have been obvious to one of ordinary skill in the art, having the teachings of Wu and Pollack and MacPhail et al. before him at the time the invention was made, to modify the messaging and receiving system and method with auto-searching for date information and prompting methods taught by Wu and Pollack to include the expiration date suggestions and selection confirmation of MacPhail et al., in order to obtain a user interface for assigning expiration dates suggested by the system. One would have been motivated to make such a combination because a user-supervised method and system for removing emails after a set date would have been obtained, as taught by MacPhail et al.

As in Claim 16, Wu teaches the input device to be a keyboard (Figure 1, Reference 114)

As in Claim 18, Wu teaches additionally storing a second message if it includes an expiration date accepted by the sender of the second message (Figure 5, Reference 526)

As in Claim 19, Wu teaches deleting the message after the expiration date (See Claim 6 rejection *supra*).

Response to Arguments

Applicant's arguments with respect to claims 1, 4-8, 14 and 16-19 have been considered but are moot in view of the new ground(s) of rejection.

In response to the argument that neither Wu nor Leonard discloses "searching user entered content and an attachment to an outgoing electronic message for date information" the examiner notes that Pollack, US Patent 6505236 more clearly addresses this feature as rejected *supra*

In response to the argument that neither Wu nor MacPhail discloses "searching user entered content and an attachment to an outgoing electronic message for date information", this feature is stated in the office action as a feature in Leonard (see above).

In response to the argument that neither Wu nor MacPhail discloses "an auto-searching module that searches within said electronic message and an attachment to said electronic message for date information", the examiner notes the rejected *supra* of claims 14 and 17, this specific limitation addressed by Pollack, US Patent 6505236.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar electronic messaging systems with expiration date determinations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M Hanne whose telephone number is (571) 272-4135. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smh


BA HUYNH
PRIMARY EXAMINER